

Beiersdorf 656.1-HCL
6713-hf 99/162**ADDITIONAL FEE**

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS***Summary of Amendments to the Claims***

Claims 7, 8, 10 and 11 have been amended to address the examiner's 35 U.S.C. 112, second paragraph rejections.

As the examiner did not suggest any amendments which would place the application in condition for allowance, claims 14-19 have been added in order to clarify the scope of the examiner's obviousness rejections, i.e. an obviousness rejection requires that each of the limitations are taught and suggested by the prior art for all claims under rejection (the presentation of the claims should not viewed as a concession as to the validity of the obviousness rejection over the broader claims).

Support for new claims 14-17 can be found, for example, on pages 21-25 and 34-38 (Examples 1-7) of the specification. Support for new claims 18 and 19 can be found, for example, on page 11 and 34-38 (Examples 1-7) of the specification.

It is believed that no new matter has been added. Claims 5-19 are now pending.

35 U.S.C. 103(a) rejections

Claims 5-13 were rejected by the examiner over Kaplan (U.S. Patent 5,989,529) or McShane et al. (U.S. Patent 6,099,825) or Hart et al. (U.S. Patent 3,970,584) in view of Phillipe et al. (U.S. Patent 6,255,332) and Hill et al. (U.S. Patent 5,730,967).

Claims 5-13 were rejected by the examiner over Thomas et al. in view of Neumiller (U.S. Patent 5,145,604).

Kaplan or McShane et al. or Hart et al. in view of Phillipe et al. and Hill et al.

Differences between primary reference and applicants' invention

Kaplan, McShane et al. and Hart et al. each differ from the applicants' claimed invention in that each are *macroemulsion* compositions.

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Additionally, Kaplan and McShane et al. disclose the use of glycerol but only as part of a generic list of ingredients for their emulsion; there is no teaching which would suggest to one of ordinary skill in the art to incorporate glycerol into their composition much less in the specific amounts required by the applicants' claim.

When viewing the invention of Kaplan and McShane et al. as a whole, it is seen that Kaplan is directed toward a sunscreen emulsion wherein an ultramarine pigment has been incorporated whereas McShane et al. is directed toward oil-in-water compositions which contain a block polymer substantive agent and a sunscreensing agent. None of the examples in Kaplan or McShane et al. suggest the use of glycerol in the amounts claimed by the applicants or the inclusion of an insect repellent.

Hart et al. lacks a teaching of glycerol and when viewing their invention as a whole, it is clear that their invention is primarily directed toward a propellant system not an O/W microemulsion, i.e. Example VI in Hart et al. stands alone as a teaching and is not a subset of a broader teaching for other embodiments of O/W microemulsions.

Thus, one of ordinary skill in the art would have to "pick and choose" elements of the teachings of Kaplan, McShane et al. and Hart et al. just to arrive at the point where the only difference between these references and that of the applicants invention is that of a macroemulsion/microemulsion. While it is well known that a prior art reference can be used for what it teaches and not just the claimed invention, MPEP 2141.02 makes the contingency that "A prior art reference must be considered in its entirety, i.e. as a whole, **including portions that would lead away from the claimed invention.**" (see MPEP 2141.02 and *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983))

It has also been held that "*it is impermissible* within the framework of section 103 **to pick and choose** from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)).

With regard to newly added claim 19, Kaplan, McShane et al. and Hart et al. do not teach the insect repellent claimed.

Phillipe et al. and Hill et al. do not remedy the differences found in Kaplan, McShane et al. and Hart et al.

Phillipe et al. is used by the examiner to establish equivalency with regard to

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macroemulsions and microemulsions. However, while a patent is considered to be enabled for the claimed invention, none of the claims of Phillippe et al. are directed toward O/W microemulsions. Moreover, Phillippe et al. is directed toward an oxazolidinone containing composition (none of Kaplan, McShane et al. or Hart et al. even in a broad sense teach the use of this compound in their invention.) which acts as an *anti-penetrating agent*. This is a teaching away from the intended use of the Kaplan, McShane et al. or Hart et al. inventions (An example in support of this assertion is a passage from McShane et al., col. 10, lines 48-50 which states "The pink sunscreen is easily visualized when spread onto the skin, but substantially disappears when rubbed into the skin.")

Hill et al. appears to be relied upon only to show that a microemulsion has certain properties which may be viewed favorably as compared to macroemulsions. However, it does not show equivalency between a microemulsion and macroemulsion or teach or suggest how a macroemulsion such as those of Kaplan, McShane et al. and Hart et al. could be converted into microemulsion form.

Summary

Therefore, the teachings of Kaplan, McShane et al. and Hart et al. contain more differences than just the form of the emulsion and even if it were conceded that the only difference was in the form of the emulsion, Phillippe et al. and Hill et al. neither teach or suggest to one of ordinary skill in the art how to modify the teachings of the primary references to arrive at the O/W microemulsions claimed by the applicants.

Thomas et al. in view of Neumiller

The examiner acknowledges that Thomas et al. does not teach glycerin as a component of their invention as claimed by the applicants (With regard to newly introduced claims 14-19, it appears that Thomas et al. do not teach these limitations) and uses Neumiller to remedy this deficiency.

However, the examiner also appears to assume that the emulsion of Neumiller is also an O/W microemulsion. Neumiller describes their invention as "...an improved emulsion system which contains *vesicle structures*..." (see col. 1, lines 13-14) and further teaches that "Three representative formulations of the invention (one of the lamellar or liquid crystal system and two of the vesicular system)..."

As can be seen in the phase diagram attached to this response (see page 21 of Exhibit A), lamellar structures have a phase boundary which is distinct from the spherical micelles of an O/W microemulsion. Moreover, referring to the definition of a microemulsion supplied with the applicant's response of 4 February 2002, a microemulsion is thermodynamically

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stable. Such that the vesicles would be considered to be "micelles", the vesicles of Neumiller are not thermodynamically stable (see col. 4, lines 27-29 of Neumiller "Next the lamellar stage is subjected to sonification, high energy shearing, or other type of energy addition."), which accounts for why Neumiller avoids characterizing their invention as being "microemulsions" but rather "an aqueous emulsion system containing vesicular structures.

As such one of ordinary skill in the art would not look to using any of the components as taught by Neumiller to be substituted into the teachings of Thomas et al. in order to produce the O/W microemulsions taught by the applicants, much less in the quantities specified in the applicants' claims.

Closing

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

NORRIS McLAUGHLIN & MARCUS, P.A.

By *Howard C. Lee*
Howard C. Lee
Reg. No. 48,104

220 East 42nd Street
30th Floor
New York, New York 10017
(212) 808-0700

HCL:vif

Attachments: Exhibit A - Classroom material from the American Chemical Society (ACS) short course "Surfactants, Micelles, Liposomes, and Liquid Crystals in Emulsions and Microemulsions", 6-10 May 2002, Clarkson University, Potsdam, NY

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (9 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 1 August 2002

By: 

Vilma I. Fernandez

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COPY OF CLAIMS SHOWING AMENDMENTS MADE

7. The **[O/W macroemulsion or]** O/W microemulsion composition of claim 6, wherein the emulsifier A or emulsifiers A is or are present in concentrations of 0.05 - 10% by weight, based on the total weight of the composition.
8. The **[O/W macroemulsion or]** O/W microemulsion composition of claim 6, wherein the emulsifier A or emulsifiers A is or are present in concentrations of 0.1 - 5% by weight, based on the total weight of the composition.
10. The O/W microemulsion composition of claim 5, wherein the total amount of one or more insect repellents **[in the finished cosmetic or dermatological preparations]** is chosen from the range 0.1 - 15.0% by weight, based on the total weight of the composition.
11. The O/W microemulsion composition of claim 5, wherein the total amount of one or more insect repellents **[in the finished cosmetic or dermatological preparations]** is chosen from the range 0.5 - 8.0% by weight, based on the total weight of the composition.

Surfactants, Micelles, Liposomes, and Liquid Crystals in Emulsions and Microemulsions

Professor Yuzhuo Li

(315) 268-2335

(315) 268-6610 Fax

yuzhuoli@clarkson.edu

Professor Stig E. Friberg

(502) 845-6990

(502) 845-8133 Fax

Sfbg@bellsouth.net

A

Revised Schedule

ACS Surfactant Short Course

May 6-10, 2002

Clarkson University

From Key Reference #1

A

